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William R. Evans
LADAS & PARRY
25 West 61st Street
New York, NY 10023

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In re Application of
KIRJAVAINEN et al
Application No.: 08/981,360
Attorney Docket No.: U 011574-0
For: AN EXTRUSION APPARATUS AND
METHOD, A TUBULAR PRODUCT, AND A
PIPE

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NOTIFICATION
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This Notification is in response to the "PRELIMINARY AMENDMENT" filed by applicants on 07 August 2000 in response to a decision on petition mailed by the United States Patent and Trademark Office (USPTO) on 13 July 2000 in application number 08/981,219. That decision involved the instant application and a copy of the decision was placed in the instant application.

BACKGROUND

On 10 June 1996, applicants filed international application PCT/FI96/00359, which claimed a priority date of 26 June 1995. A copy of the earlier international application was communicated to the USPTO from the International Bureau on 16 January 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 22 January 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 December 1997.

On 18 December 1997, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a check for \$1,070.00; a copy of the international application; a "translation" of the international application into English (note that the term "translation" is confusing since the copy of the international application is itself in English and thus a translation into English is not required); an authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011574-0 and was assigned application number 08/981,360 (the '360 application) by the United States Patent and Trademark Office (USPTO). The "translation" does not appear to be identical to the published international application. (Although the two have not been compared line by line, it is noted that at least the

titles are different.)

On 19 December 1997, applicants filed another transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a check for \$1,070.00; a copy of the international application; a "translation" of the international application into English (the term "translation" is confusing since the copy of the international application is itself in English and thus a translation into English is not required); an authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011572-4 and was assigned application number 08/981,219 (the '219 application) by the USPTO. The "translation" provided with this submission does not appear to be identical to either the international application or the "translation" filed 18 December 1997.

On 19 December 1997, applicants also filed another transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a copy of the international application; a "translation" of the international application into English (the term "translation" is confusing since the copy of the international application is itself in English and a translation into English is not required); an authorization to charge any additional fees to counsel's Deposit Account No. 12-0425; and a preliminary amendment. This submission was identified by applicants as having attorney docket number U 011573-2. It was placed by the USPTO in the '219 application. Both of the submissions filed 19 December 1997 appear to have been in the same envelope as both are identified by the same "Express Mail" mailing number--EI528037962US. The "translation" provided with this submission does not appear to be identical to the international application or to either of the "translations" mentioned above.

On 08 October 1998, applicants filed a "REQUEST FOR NATIONAL PHASE ENTRY" including copies of the transmittal letter filed 18 December 1997, a postcard receipt, and a declaration of the inventors. This submission was not identified with an application number but did identify the attorney docket number as U 011574-0.

On 22 February 1999, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) in the '219 application indicating, *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) were required.

On 08 March 1999, the USPTO mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according the '219 application 35 USC 102(e) and 371 dates of 08 October 1998.

On 17 March 1999, applicants filed the present petition requesting that the '219 application be converted from an application filed under 35 U.S.C. 371 to one filed under 35 U.S.C. 111. The petition was accompanied by an authorization to charge \$130.00 for the

requisite petition fee.

On 13 July 2000, the USPTO mailed a decision granting applicants' petition. That decision noted, *inter alia*, that:

- papers identified by applicants as having attorney docket number U 011574-0 were placed in and assigned application number 08/981,360;
- papers identified by applicants as having attorney docket number U 011572-4 were placed in and assigned application number 08/981,219;
- papers identified by applicants as having attorney docket number U 011573-2 were placed in application number 08/981,219 but were not assigned an application number;
- the declaration filed 08 October 1998 was ultimately placed in the '360 application.
- the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 mailed 08 March 1999 in application number 08/981,219 was vacated;
- application number 08/981,219 would be the national stage of PCT/FI96/00359;
- in application number 08/981,219, applicants were required to (1) file an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and (2) clarify what was intended with the submission filed 19 December 1997 having docket number U 011573-2;
- in application number 08/981,360, applicants were required to (1) file a new oath or declaration in compliance with 37 CFR 1.63 and (2) identify which of the two specifications filed on 18 December 1997 is to be used as the specification for application number 08/981,360; and
- a copy of the decision would be placed in application number 08/981,360.

On 07 August 2000, applicants filed in application number 08/981,360, a preliminary amendment and a copy of the specification, claims, abstract and drawings filed 18 December 1997 which applicants intend to be examined.¹

¹The application papers in the instant file wrapper filed by applicants are:

- papers received on 18 December 1997 and identified by applicants by having attorney docket U 011574-0,
 - transmittal letter;
 - preliminary amendment;
 - copy of request;
 - copy of the international application as filed;
 - international publication number WO 97/01429 including search report;
 - international preliminary examination report including Annexes;
 - copy of Form PCT/IB/304;
 - copy of Form PCT/IB/332;
 - copy of Form PCT/ISA/206;
 - copy of Form PCT/ISA/210; and
 - copy of four sheets of formal drawings;
- preliminary amendment filed 07 August 2000;
- Information Disclosure Statement (IDS) filed 04 August 2000 (which does not appear to include a Form PTO-1449)
- IDS filed 07 August 2000;
- IDS filed 29 January 2001; and
- Supplemental IDS filed 28 February 2001.

DISCUSSION

The preliminary amendment filed 07 August 2000 claims benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter.

The preliminary amendment filed 07 August 2000 also indicates that it is the "translation" filed 18 December 1997 which is to be examined rather than the copy of the international application which was also filed 18 December 1997. (It is noted that it is the copy of the "translation" filed 18 December 1997 which will be examined rather than the copy filed along with the preliminary amendment on 07 August 2000.)

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

It is noted that the declaration in application number 08/981,360 is defective. The declaration is directed to the specification which "was described and claimed in PCT International Application No. PCT/FI96/00359 filed on 20 June 1996." Since applicants filed both a copy of the international application and a "translation" which is not identical to the copy of the international application, and applicant intends for the "translation" to be examined, the declaration executes the wrong specification.

CONCLUSION

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

This application will be forwarded to the ~~Office of Initial Patent Examining~~ ^{PCT Office} for processing as an application under 35 U.S.C. 111(a) having a filing date of 18 December 1997.



Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (703) 308-6459